

§103(a) over Wallace/McCrea/Gopinathan and further in view of Richardson (“Richardson”; “Neural Networks Compared to Statistical Techniques”).

No claims are added or deleted. Hence, Claims 17-30 are presently pending in this application.

#### REJECTIONS NOT BASED ON PRIOR ART

In paragraph 4 of the Office Action, Claims 17-30 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 1 of U.S. Patent No. 6,029,154. Applicant disagrees with the rejection, but to expedite prosecution a terminal disclaimer is submitted herewith that fully overcomes the grounds for rejection.

#### REJECTIONS BASED ON PRIOR ART

Paragraph 6 of the Office Action rejected Claims 17-26 and 28-30 under 35 U.S.C. §103(a) as allegedly unpatentable over Wallace in view of McCrea, further in view of Gopinathan. Applicant respectfully traverses this rejection.

With respect to Claim 17, there is no suggestion or motivation to one skilled in the art to combine the teachings of Wallace and McCrea and Gopinathan to arrive at the invention recited in Claim 17. Thus, a prima facie case of obviousness has not been established based on the references of record.

The Office Action is correct that “Wallace fails to teach use of an Internet address in the detection of fraud in a credit card transaction by verifying if the information about physical addresses associated with the internet addresses used in the transactions are consistent.” However, the allegation that “[i]n view of McCrea it would have been obvious

... to modify Wallace to use Internet address in detecting credit card fraud detection by verifying information about physical address associated with the Internet address used in the transaction” is incorrect. McCrea does not teach the subject matter of the claim, and there is no suggestion to apply the teachings of McCrea in the field of fraud control.

McCrea is a report prepared for the Australian Taxation Office. At most, McCrea describes use of an IP address to determine whether an associated host is within Australia based on connections of Australia to the Internet and on subnet address ranges that collectively define all IP addresses in Australia. McCrea does not disclose comparing consistency of one **physical** address with another. McCrea provides no teaching or suggestion of linking an Internet address with a physical address, beyond the level of determining whether the Internet address is associated with subnets in Australia. Further, McCrea does not access a **database of historical transaction records for verification** purposes with respect to the link between a given Internet address and associated physical address(es).

The apparent purpose of the described process is for determining whether online purchases by the host could be subject to Australian sales tax. There is no suggestion to apply McCrea in the field of **fraud detection**, to which Claim 17 is directed.

The Action attempts to stitch together the features of Claim 17 using the claim as an instruction manual to find prior art that allegedly renders Claim 17 obvious, thereby impermissibly applying hindsight. The Court of Appeals for the Federal Circuit (CAFC) has stated that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne

cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

*In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

In this case, it would not have been obvious to one skilled in the relevant art at the time of the invention to combine the cited references at least for the reason that one would not look to McCrea for teachings with respect to fraud detection and control. Further, one skilled in the art would not look to McCrea, which is in the field of taxation, for a teaching regarding “**verifying** the credit card information based upon an Internet identification system that determines whether a **physical address** specified in the transaction information is **consistent with other physical addresses** that have been **specified in a database of records of other transaction information for other transactions** that are associated with the Internet address of the consumer,” as recited in Claim 17.

To summarize, the McCrea disclosure (1) fails to teach the feature of Claim 17 on which the Office Action relies; (2) fails to suggest a combination with the non-analogous teachings of Wallace and Gopinathan; and (3) is in a field that is not analogous with fraud detection. In general, the Office Action refuses to recognize and acknowledge the non-obviousness of **integrating an Internet address-based feature into a Internet credit card fraud detection process, utilizing a database of historical transaction information, through verification of a current physical address in view of historical physical addresses associated with the same Internet address**. Respectfully, such a complex process as recited in Claim 17 should not stand rejected as obvious at the time of filing based on such a complicated, albeit crafty, combination of disparate references.

Furthermore, the CAFC has stated that “the actual determination of the [obviousness] issue requires an *evaluation ... of the claimed invention as a whole*” (emphasis added; Lear

Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 221 USPQ 1025, 1033 (Fed. Cir. 1984)).

Hence, each feature of a claim should be evaluated in view of the subject matter of the entire claim and in view of the feature's interaction with other features in the claim.

In this case, reliance on three references for an obviousness rejection, one of which is not in the same field as the other references, gives the appearance that the invention recited in Claim 17 is not being evaluated as a whole. For all of the foregoing reasons, a prima facie case of obviousness has not been made. Therefore, Claim 17 is patentable over the references of record and withdrawal of the rejection of Claim 17 is respectfully requested.

Claims 18-23 depend directly or indirectly from Claim 17, and are thus patentable over the prior art of record for at least the same reasons presented above in reference to Claim 17. Therefore, withdrawal of the rejection of Claim 18-23 is respectfully requested.

In addition, with respect to Claim 21, to which it is inferred the Office Action is referring in the discussion of the use of weights (page 7, first full paragraph of Office Action), Official Notice is taken of the concept of applying weights to parameters. However, Applicant is not claiming the application of weighting factors to parameters, *per se*. Rather, Claim 21 in conjunction with its parent Claim 17 recite weighting each verification step according to importance **determined by the merchant**. Providing such a weighting capability to a merchant, **as a client of a fraud detection service or method**, is not a trivial matter. Therefore, Official Notice with respect to letting merchants determine the weights is insufficient substantiation for a rejection of Claim 21. It again appears that impermissible hindsight is being applied in the rejection of this claim.

Claim 24 is an independent claim that includes steps of (1) verifying credit card information based on an Internet identification system that determines consistency between a

physical address and an Internet address associated with a consumer in a transaction; and (2) receiving from a merchant weight values associated with each of a plurality of mechanisms for detecting fraud in a credit card transaction. Each of these features has been discussed above in reference to Claim 17 and Claim 21, respectively. Thus, based on the foregoing reasons, the references of record do not teach, disclose, or suggest these features. Therefore, a prima facie case of obviousness is not established and Claim 24 is patentable over the references of record. Withdrawal of the rejection of Claim 24 is respectfully requested.

Claims 25-27 depend directly or indirectly from Claim 24, and are thus patentable over the prior art of record for at least the same reasons presented above in reference to Claim 24. Therefore, withdrawal of the rejection of Claim 25-27 is respectfully requested.

Paragraph 6 of the Office Action rejected Claim 27 under 35 U.S.C. §103(a) as allegedly unpatentable over Wallace in view of McCrea, further in view of Gopinathan, further in view of Richardson. Applicant respectfully traverses this rejection.

With respect to Claim 27, the Office Action contends that Richardson teaches the construction and use of maps of credit card transactions. However, Richardson does not teach, disclose or suggest constructing a map of credit card transactions that **utilize a specific Internet address** that is identified with the transaction. Furthermore, as discussed above in reference to Claim 17, none of the references of record teach, suggest or make obvious the use of Internet addresses in the manner used in the present application. Therefore, Claim 27 would not have been obvious in view of the references of record. Withdrawal of the rejection of Claim 27 is, therefore, requested.

Claim 28 is a system claim and Claim 29 is a computer-readable medium claim, both of which comprise features similar to method Claim 17. Therefore, Claims 28 and 29 are

patentable over the references of record for at least the same reasons given above for Claim 17. Withdrawal of the rejections of Claims 28 and 29 is respectfully requested.

Claim 30 is an independent claim that includes use of an Internet verification system to verify credit card information by determining whether a physical address specified in transaction information is consistent with other physical addresses specified in a database of transaction information for other transactions associated with the consumer's Internet address. As shown above in reference to Claim 17, the references of record do not teach, disclose, suggest or make obvious the use of an Internet verification system that functions with respect to physical and Internet addresses, as described and claimed in the application. Hence, Claim 30 is also patentable over the references of record for at least the same reasons as Claim 17 and, therefore, withdrawal of the rejection of Claim 30 is respectfully requested.

#### CONCLUSION

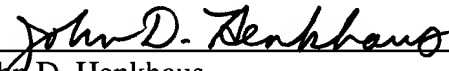
For at least the reasons indicated above, Applicants submit that all the pending claims (17-30) present subject matter that is patentable over the references of record, including that which was cited but not applied, and are in condition for allowance. Therefore, Applicants respectfully request timely issuance of a Notice of Allowance. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully Submitted,

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on 2/28/03 by Clare Fung